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**REMARKS**

Claims 1-6, 8-14, 16, and 17 are currently pending in the above-identified patent application.

In the subject Office Action, claims 1, 3, 5, 8, 10, 11, 13, and 16 were rejected under 35 U.S.C. 102(b) as being anticipated by Nolen (U.S. Patent No. 590,330), since the Examiner stated that regarding claims 1, 3, 8, 10, 11, 13 and 16, Nolen shows the claimed invention. Further, the Examiner continued, Nolen's pin (a3) is considered "flexible" since virtually anything will flex if enough pressure is applied to it. The Examiner also stated that regarding claim 5, the rivet (a3) meets the claim language, since a rivet is a metal bolt or pin having a head on one end, inserted through aligned holes in the pieces to be joined and then hammered on the plain end so as to form a second head, and that before the plain end of the rivet (a3) is hammered, the rivet meets the claim language.

Applicant respectfully disagrees with the Examiner concerning these grounds of rejection for the reasons to be set forth hereinbelow.

Claims 2, 4, and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nolen, since the Examiner stated that Nolen shows the claimed invention except it is silent about the material the pin (a3) is made of, and the location of the hole (i.e., the hole through which the pin (a3) extends) with respect to the open portion of the thumb ringlet (a4). The Examiner continued that to select a well known material such as plastic for Nolen's pin (a3) would have been obvious to one having ordinary skill in the art, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Further, the Examiner stated, it would have been obvious to one of ordinary skill in the art at the time the invention was made to re-arrange Nolen's open portion so that it is disposed approximately opposite to the hole in the thumb ringlet (a4), since it has been held that rearranging parts of an invention involves only routine skill in the art.

Applicant respectfully disagrees with the Examiner concerning this ground of rejection for the reasons to be set forth hereinbelow.

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Claims 6 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Mock (U.S. Patent No. 6,131,291), since the Examiner stated that Nolen shows the claimed invention except that it lacks means for adjusting the force between opposing cutting portions (A, B) of the scissors, while Mock shows a pair of shears comprising means (20, 25) for adjusting the force of the shear blades. The Examiner concluded that it would have been obvious to one skilled in the art to further modify Nolen by providing the scissors with force adjusting means to facilitate adjusting the ride of the blades as taught by Mock.

Applicant respectfully disagrees with this ground of rejection for the reasons to be set forth hereinbelow.

Claims 9 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Brenton (U.S. Patent No. 5,469,624), since the Examiner stated that Nolen shows the claimed invention except that it lacks a finger stabilizer, while Brenton shows a pair of scissors comprising a finger stabilizer disposed in the vicinity of a finger ringlet. The Examiner concluded that it would have been obvious to one skilled in the art to modify Nolen by providing the finger ringlet (B3) with a finger stabilizer for supporting a user's finger when in use as taught by Brenton.

Applicant respectfully disagrees with the Examiner concerning this ground of rejection for the reasons to be set forth hereinbelow.

Turning now the Examiner's interpretation of the word "flexible" in the subject claims, court decisions have addressed the interpretation of claims requiring that a material be flexible. For example, in *Harrington Mfg. Co. v. White*, 414 U.S. 1040, 179 USPQ 705 (1973), the court concluded that flexible in claims means adjustable. In Col. 2, lines 57-66, of Nolen it is stated that: "Upon the handle A<sup>2</sup>, adjacent to its rear end, is mounted a thumb-holder or ring, a<sup>2</sup>, preferably of sheet metal, pivoted thereto by means of a double-headed pin or rivet a<sup>3</sup>, headed loosely enough to permit said ring to be rotated on the surface of the handle in any direction desired and be retained generally at right angle or across the handle when the blades are pushed away from the operator." (emphasis added by applicant). In Col. 3, lines 4-9, it is stated that: "Although the thumb-handle A<sup>2</sup> is preferably provided with the

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ring  $a^2$  as a thumb-retainer, the thumb-retainer may be in the form of a loop, as shown at  $a^4$  in Fig. 6, that is pivotaly retained by means of the double-headed pin  $a^3$ ." (emphasis added by applicant). Clearly, there is no adjustment possible in the rivet of Nolen, since the thumb ring of Nolen is retained generally at right angle across the handle when the blades are pushed away from the operator, as stated in the very specific language of Nolen: "... said ring to be rotated on the surface of the handle in any direction desired and be retained generally at right angle ... ." (emphasis added by applicant), and which specifically requires no flexibility of the rivet.

Further, In re Gordon, 735 F.2d900, 221 USPQ 1125 (Fed. Cir., 1984) states that: "... The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. ... Indeed, if the French apparatus were turned upside down, it would be rendered inoperable for its intended purpose. ... In effect, French teaches away from the board's proposed modification." Thus, if the flexible pin of the present invention were substituted for the pin of Nolen, as suggested by the Examiner, the clearly recited function of the thumb ring of Nolen would be lost. Therefore, applicant believes that Nolen teaches away from the subject claimed invention.

The Third Edition of The American Heritage Dictionary Of The English Language, copyright 1992 by Houghton Mifflin Company, defines a rivet as: "A metal bolt or pin having a head on one end, inserted through aligned holes in the pieces to be joined and then hammered on the plain end so as to form a second head." The Fifth Edition of the Dictionary of Scientific And Technical Terms, copyright 1994 by McGraw-Hill, Inc. provides but a single mechanical definition for "flexibility" as: "The quality or state of being able to be flexed or bent repeatedly." (emphasis added by applicant). As can be seen from the requirement of a rivet by Nolen, a metal pivoting device is contemplated. Clearly, a metal rivet as recited by Nolen cannot be flexed or bent repeatedly, since metals are well known to work harden and become brittle when flexed repeatedly. The Third Edition of The American Heritage Dictionary Of The English Language, *supra*, reinforces this

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definition of "flexible" with: "Capable of being bent repeatedly without injury or damage." (emphasis added by applicant). Thus, the rivet of Nolen does not meet the requirement of a "flexible pin" recited in subject claims 1 and 11, as originally filed.

In the subject Office Action, the Examiner rejected claims 1, 3, 5, 8, 10, 11, 13, and 16 under 35 U.S.C. 102(b) as being unpatentable over Nolen (U.S. Patent No. 590,330, stating that Nolen shows the claimed invention, and that Nolen's pin (a3) is considered "flexible" since virtually anything will flex if enough pressure is applied to it. Applicant wishes to point out that the Examiner has quoted only a portion of the statement in *Fredman v. Harris-Hub Company, Inc.; Same v. Estee Sleep Shops, Inc.* The quotation actually is: "The Court finds that the words "flexibility" or "rigidity" are relative terms, particularly since virtually anything will flex if enough pressure is applied to it. The Court finds that the Harris-Pub rails do not meet the first requirement of Claim 4 in that such rails are not designed to flex at their end portions and are not capable of being resiliently laterally deflected." This statement is immediately preceded by the statement: "Claim 4 is not infringed if the end portions of the accused rails do not flex, i.e., if such end portions are not 'capable of being resiliently laterally deflected' as recited in claim 4." (emphasis added by applicant). The Court then went further, stating: "The lateral deflection referred to in Claim 4 is not insignificant in amount; the patent teaches that when each side rail is moved inwardly one inch the end portions of each rail are laterally deflected as much as one inch. ... Plaintiff's expert witness, Mr. Benjamin, made a courtroom demonstration in an attempt to show that the end portions of the accused Harris-Pub rails were capable of flexing. Mr. Benjamin admitted that the Harris-Pub rails could not flex in the manner of the patent in suit and further testified that the amount of deflection which he measured was, while significant for that type of rail, quite different from what is stated in the patent in suit. Mr. Benjamin testified that he used a test rig rather than a bed because it was too difficult to control the many movements of a rail in a bed; he admitted that the measurements he made in his test rig included extraneous movements other than the lateral deflection being measured. ... Claim 4 of the patent in suit is not infringed by any structure made,

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used or sold by either of the defendants herein."

Clearly, the Court is not applying the statement quoted by the Examiner in the manner in which the Examiner is applying this statement to the Nolen invention. The Court has stressed that flexibility is determined by the conditions under which the invention is used, rather than adhering to the statement that "... virtually anything will flex if enough pressure is applied to it." Certainly, if one placed the scissors of Nolen in a vice or grabbed the scissors with pliers, the rivet could be bent a couple of times before breaking. However, under the considerably reduced forces generated by the fingers of a barber, Nolen's rivet does not bend, and does not attain the adjustability of a flexible pin.

Regarding claim 5, the Examiner stated that the rivet (a3) meets the claim language, since a rivet is a metal bolt or pin having a head on one end, inserted through aligned holes in the pieces to be joined and then hammered on the plain end so as to form a second head, and before the plain end of the rivet (a3) is hammered, the rivet meets the claim language. Applicant respectfully disagrees with this statement, since claim 5 recites: "... wherein said flexible pin has a forward portion and a rearward portion ... such that the forward portion of said flexible pin is captured in the tubular portion of said first shaft when said flexible pin is inserted therethrough." The rivet of Nolen is clearly not captured by handle (A2) as suggested by the Examiner. The rivet of Nolen is inserted therethrough before a second head is formed as clearly stated by the Examiner. Only then are the thumb ring (a2) and handle (A2) pivotably joined. Moreover, Nolen does not teach that thumb ring (a2) and handle (A2) are joined by a rivet wherein the plain end is not hammered. In fact, the invention of Nolen would not function with an incomplete rivet. Thus, as stated in *In re Gordon, supra*: "... The mere fact that the prior art could be so modified would not have made the modification obvious unless he prior art suggested the desirability of the modification. ... Indeed, if the French apparatus were turned upside down, it would be rendered inoperable for its intended purpose. ... In effect, French teaches away from the board's proposed modification." Thus, applicant believes that the Examiner has additionally incorrectly rejected subject claim 5 as being anticipated by Nolen, since there would be no motivation to

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use a rivet for which the plain end was not hammered.

Applicant therefore believes that Nolen in fact does not anticipate the present claimed invention; rather, Nolen teaches away therefrom.

Applicant respectfully disagrees with the Examiner's assertion that Nolen shows the claimed invention except that it is silent about the material the pin (a3) is made of, and the location of the hole through which the pin (a3) extends with respect to the open portion of the thumb ringlet (a4), in the rejection of claims 2, 4, and 12 under 35 U.S.C. 103(a) as being unpatentable Nolen, and the Examiner's conclusion that to select a well-known material such as plastic for Nolen's pin (a3) on the basis of its suitability for the intended use, would have been obvious to one having ordinary skill in the art. As noted hereinabove, Nolen clearly meant that a metal pin be utilized because a metal pin is the well-known meaning of the word "rivet." Further, a metal pin has the requisite lack of adjustability required by Nolen.

Applicant also respectfully disagrees with the Examiner's conclusion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to rearrange Nolen's open portion so that it is disposed approximately opposite to the hole in the thumb ringlet (a4), since it has been held that rearranging parts of an invention involves only routine skill in the art. As shown in Fig. 6 of Nolen, the pivot mount must be located near the open end of the loop if the stated use of the loop in Col. 3, lines 9-11: "As the loop a<sup>4</sup> has one end open it can be used also as a hook to suspend the scissors from the garments of a person.", is to be realized. To place the point of rotation elsewhere would effectively defeat the suspension function of the loop.

Again, applicant wishes to direct the Examiner's attention to *In re Gordon*, *supra*, and respectfully believes that the Examiner has not made a proper *prima facie* obviousness rejection of claims 2, 4, and 12 under 35 U.S.C. 103(a).

Moreover, Nolen specifies thumb holder a<sup>2</sup> as either a ring or a loop, not a "substantially circular thumb ringlet having an open portion and a hole" as recited in subject claims 1 and 10.

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Claims 6 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Mock (U.S. Patent No. 6,131,291), and claims 9 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Brenton et al. (U.S. Patent No. 5,469,624). As stated hereinabove, Nolen clearly teaches away from the present claimed invention, and cannot properly be combined with other references in a rejection under 35 U.S.C. 103(a) as has been done by the Examiner. Since the Examiner has incorrectly combined Nolen with Mock and Brenton et al., applicant believes that the Examiner has failed to make a proper *prima facie* case of obviousness as is required under 35 U.S.C. 103(a) in the rejection of claims 6 and 14, claims 9 and 17, respectively.

In view of the discussion presented hereinabove, applicant believes that subject claims 1-6, 8-14, 16, and 17 are in condition for allowance or appeal, the former action by the Examiner at an early date being earnestly solicited.

Reexamination and reconsideration are respectfully requested.

Respectfully submitted,

COCHRAN FREUND & YOUNG LLC

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By: 

Samuel M. Freund

Reg. No. 30,439

2026 Caribou Drive, Suite 201

Fort Collins, Colorado 80525

Phone: (970) 492-1100

Fax: (970) 492-1101

Customer No. 27,479